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R. Ellis

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: McCollum, et al.
Serial No: 09/589,647
Confirmation No: 8728
Filed: June 7, 2000
For: METHOD AND SYSTEM FOR OBTAINING HEALTH-RELATED RECORDS AND DOCUMENTS USING AN ONLINE LOCATION
Examiner: Natalie Pass
Art Unit: 3626

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APPEAL BRIEF PURSUANT TO 37 C.F.R. §41.37

This brief and fee of \$165 for a small entity under 37 C.F.R. §41.20(b)(2), are submitted in furtherance of the Notice of Appeal filed on February 12, 2004 in the above-referenced application.

A petition and fee for a five-month extension of time also is enclosed herewith. Any additional fees required for consideration of this paper are authorized to be charged to the deposit account identified on the two copies of the Transmittal of Appeal Brief filed herewith.

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I. Real Party in Interest (37 C.F.R. §41.37(c)(i))

The real party in interest in this application is the assignee, ChartOne, Inc., a DE corporation with a place of business at 31 North Washington St., North Attleboro, Massachusetts 02760.

II. Related Appeals and Interferences (37 C.F.R. §41.37(c)(ii))

There are no other appeals or interferences known to the appellant, the appellant's legal representatives, or the assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims (37 C.F.R. §41.37(c)(iii))

Claims 1-26 are pending in this application, of which claims 1, 2 and 16 are independent claims. Each of these claims was finally rejected in an Office Action dated August 12, 2003. The rejections of claims 1-26 are appealed. A copy of the claims, as pending, is attached as an Appendix.

The status of the claims is as follows:

- A. Claims 1-2, 4-10 and 12-26 stand rejected under 35 U.S.C. §103(a) as allegedly being obvious based on U.S. Patent No. 5,659,741 to Eberhart (hereinafter "Eberhart") in view of U.S. Patent No. 5,737,539 to Edelson, et al. (hereinafter "Edelson").
- B. Claims 3 and 11 stand rejected under 35 U.S.C. §103(a) as allegedly being obvious based on Eberhart in view of Edelson and further in view of U.S. Patent No. 6,018,713 to Coli, et al. (hereinafter "Coli").

IV. Status of the Amendments (37 C.F.R. §41.37(c)(iv))

No amendment has been filed subsequent to the Final Office Action.

V. Summary of Claimed Subject Matter (37 C.F.R. §41.37(c)(v))

The invention involved in this Appeal is directed generally to method and system for obtaining records, for example health-related record, using an online location. One example of

where certain embodiments of such a system can be useful is when an insurance company needs to coordinate access of a client's medical records. In such systems the insurance company needs to get patient records from a medical facility and the patient/applicant's consent needs to be obtained.

As recited in independent claim 1, an aspect of the invention is directed to a method of obtaining a patient record or document using an online location on an electronic medium. For example, the online location may be a website 12 (e.g., FIG. 1-3; page 6, lines 5-10; page 6, lines 20 – page 7, line 3). The method of obtaining records may involve requesting, by a requestor, an order for a patient record or a document 404 directly or indirectly from a website, such as an electronic health information (EHI) provider website (e.g., FIG. 1-2, 4; page 7, lines 11-13, 21-24; page 10, lines 1-6). For example, a request may be made via a user interface on the website, through which patient information (e.g., first name, last name, social security number) is entered (e.g., FIG. 5A-5F; page 10, lines 6-10). The method may involve providing to the requestor a cover letter having an identifier having order information 414 (e.g., FIG. 4). For example, the cover letter may be an authorization for release of records and documents and the cover letter has an identifier such as a barcode (e.g., FIG. 6; page 11, lines 9-16). Further, the method may include sending, by the requestor, a printed copy of the cover letter along with a patient authorization letter to a processing center 418, for completing the order 418 (e.g., sending the documents)(e.g., FIG. 4). For example, the cover letter and authorization letter can be faxed or mailed to an EHI provider (e.g., page 11, lines 18-21). The method may also include, upon approval of the cover letter and authorization letter, requesting (by the EHI provider) that a shipping location ship a record or document corresponding to the identifier to the requestor, such that the record or document is obtained by the requestor 420 (e.g., FIG. 4; page 3, lines 20-23; page 4, lines 1-3; page 13, lines 10-19).

Independent claim 16 is directed to a method comprising a subset of the steps recited in claim 1, namely requesting an order for a patient record or a document from an online location; providing to a requestor a cover letter having an identifier; and sending the cover letter along with a patient authorization letter to a processing center.

As recited in independent claim 2, an aspect of the invention is directed to a system for obtaining a patient record or document using an online location on an electronic medium. For

example, the online location may be a website 12 (e.g., FIG. 1-3; page 6, lines 5-10; page 6, lines 20 – page 7, line 3). The system may include a means for requesting, by a requestor, an order for a patient record or a document directly or indirectly from a website, such as an EHI provider website (e.g., FIG. 1-2, 4; page 7, lines 11-13, 21-24; page 10, lines 1-6). For example, a request may be made via a user interface 500 on the website, through which patient information (e.g., first name, last name, social security number) is entered (e.g., FIG. 5A-5F; page 10, lines 6-10). The system may include a means for providing to the requestor a cover letter 12 having an identifier having order information (e.g., page 11, lines 11- 19). For example, the cover letter may be an authorization for release of records and documents and the cover letter has an identifier such as a barcode 604 (e.g., FIG. 6; page 11, lines 9-16). Further, the system may include a means for sending, by the requestor, a printed copy of the cover letter along with a patient authorization letter to a processing center 30, 32, 34, for completing the order (e.g., sending the documents)(e.g., FIG. 4). For example, the cover letter and authorization letter can be faxed or mailed to an EHI provider (e.g., page 11, lines 18-21). The system may also include a means for requesting (by the processing center) that a shipping location ship a record or document corresponding to the identifier (e.g., page 8, lines 12-15; page 13, lines 17-19) to the requestor. The system may further include a suitable means for receiving, by a destination location, the patient record or document from the shipping location (e.g., page 3, lines 20-22; page 4, lines 1-4). Finally, the system may include a means for obtaining the patient record or document from the destination location (e.g., page 3, lines 22-23, page 4, lines 1-4).

VI. Grounds of Rejection to be Reviewed on Appeal (37 C.F.R. §41.37(c)(vi))

A. Whether the rejections of claims 1-2, 4-10, and 12-26 as allegedly being obvious over Edelson in view of Eberhardt should be reversed, when Edelson and Eberhardt completely fail to disclose at least two features in each of the claims.

B. Whether the rejections of claims 3 and 11 as allegedly being obvious over Edelson in view of Eberhardt and Coli should be reversed, when Edelson and Eberhardt completely fail to disclose at least two features in each of the claims and Coli fails to overcome the deficiencies of Edelson and Eberhardt.

VII. Argument (37 C.F.R. §41.37(c)(vii))

Applicant respectfully requests that the Examiner's final rejection of claims 1-26 be reversed. The claims as presented are believed to be in allowable condition.

A. Discussion of the Cited Prior Art

Eberhardt discloses a computerized system and method for storing medical histories using a card-sized storage device (e.g., abstract). Eberhardt discloses that the storage device can be carried by a person such that the person's medical history would be available to a health care specialist when the person is examined (col. 1, lines 33-38).

Edelson is directed to a prescription management system for electronic prescription creation by a prescriber at a point of patient care, to produce a prescription useable by a pharmacist to dispense drugs. The prescription creation system is intended to "solve ... the problem of providing a computerized, prescription management system that an average prescribing physician can use and will want to use and which makes possible significant improvements in the quality of prescriptions written" (col. 4, lines 16-21). The system provides information correlating medical conditions and drug treatment regimes. (e.g., col. 5, lines 40-44). Edelson discloses that the system may provide various types of security such as signature recognition (col. 9, lines 23-28), a password or access code system to limit access to information (col. 9, line 66 to col. 10, line 14), dynamic retrieval of electronic information in which patent data is received from multiple database they are integrated to form virtual patient record (col. 15, lines 13-28), distinct patient identifiers such as social security numbers, other alphanumeric identifiers, fingerprints or photographs (col. 17, lines 27-42), and audit trails that indicate when and how much data was accessed (col. 17, lines 43-46).

Coli is directed to a network-based system and method for ordering and reporting cumulative results of medical tests (abstract). A physician's computer receives a physician or user request for ordering a test, causing a test-request message to be sent to a labsite computer, and causing a request for statistical data to be sent to be sent to a network (abstract). The labsite computer is programmed to receive the test request and to cause a test result message and test status message to be sent to the physician's computer (abstract).

B. The Rejections of Claims 1-26 Should Be Reversed.

The Final Office Action rejected Group I claims 1-2, 4-10 and 12-26 under 35 U.S.C. §103 as being obvious over Eberhardt in view of Edelson; and claims 3 and 11 under 35 U.S.C. §103 as being obvious over Eberhardt in view of Edelson and Coli. These rejections should be reversed.

1. Claims 1-26 are Not Obvious Over Eberhardt in view of Edelson.

As set forth in MPEP §2143, three criteria must be met in order to establish a prima facie case of obviousness. First, the reference(s) must teach or suggest all of the claimed features. Second, there must be some specific suggestion or motivation, either in the cited reference(s) or in the knowledge generally available to one of ordinary skill in the art, to modify the reference(s) in a way that results in the claimed invention. Third, there must be a reasonable expectation of success. The specific teaching or suggestion to modify the reference(s) must be found in the prior art and not based on Applicants' disclosure. See In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). What is more, to support a prima facie obviousness rejection, the Office Action must specifically cite the motivation. In re Dembiczak, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999)

In the present application, the Final Office Action fails to establish any of these elements a prima facie case of obviousness and therefore has not made out a prima facie case of obviousness.

Regarding the first element of obviousness, Eberhardt and Edelson fail to disclose or suggest two features of claim 1, specifically "providing to the requestor a cover letter having an identifier, the identifier having order information" and "sending, by the requestor, the cover letter along with a patient authorization letter to a processing center, for completing the order."

In a sense, this could hardly be surprising. Eberhardt is set in an entirely different context and therefore discloses a very different system. Eberhardt is directed to a computerized system and method for storing medical histories using a card-sized storage device for patients to carry around with them. It is not directed to secure patient record or document retrieval at all.

Consequently, the Examiner does not allege that Eberhardt discloses or suggests either of the claim elements of "providing to the requestor a cover letter having an identifier, the identifier

having order information” or “sending, by the requestor, the cover letter along with a patient authorization letter to a processing center, for completing the order.” Indeed, neither step is disclosed in Eberhardt.

These elements are not even remotely disclosed in Edelson either.

a. “providing to the requestor a cover letter having an identifier, the identifier having order information”

In fact, the only two portions of Edelson cited in the Final Office Action, namely col. 16, lines 10-24 and col. 17, lines 5-62, indisputably fail to disclose “providing to the requestor a cover letter having an identifier, the identifier having order information,” as recited in claim 1.

Col. 16, lines 10-24 of Edelson discusses a technique of dynamic retrieval of electronic information in which patient data is received from multiple databases and integrated to form a virtual patient record (for purposes of filling a prescription) that disappears after use (see col. 15, lines 13-15 and 33-34). The discussion says nothing about providing a requestor with a cover letter nor would a cover letter make any sense in the context of Edelson (i.e., filling a prescription).

Col. 17, lines 5-62 of Edelson discusses patient data security, including authorization techniques such as the use of photographic or fingerprint recognition to identify a system user, but says nothing about providing a requestor with a cover letter and, again, the context of Edelson (filling a prescription when the patient is there) simply does not lend itself to the notion of a cover letter.

Thus, while claim 1 recites a step of “requesting an order, by a requestor, for [a] a patient record or document...” and claim 1 recites “providing to the requestor a cover letter having an identifier, the identifier having order information,” it is unimaginable that Edelson would teach (or have any need) for either when a prescription is being filled at the point of patient care.

In the claim, the requestor requests an order and receives a cover letter having an identifier including order information in return. By contrast, Edelson does not disclose or suggest providing a cover letter having an identifier including order information, much less providing a cover letter *to a requestor* who requests a patient record or document.

b. “sending, by the requestor, the cover letter along with a patient authorization letter to a processing center, for completing the order”

Edelson also does not disclose “sending, by the requestor, the cover letter along with a patient authorization letter to a processing center, for completing the order.”

The portions of Edelson cited in the Final Office Action, namely col. 9, lines 23-28, col. 9, line 66 – col. 10, line 14, col. 15, lines 25-27, col. 16, lines 10-24, col. 17, lines 5-62 and col. 31, lines 55-63, fail to disclose “sending, by the requestor, the cover letter along with a patient authorization letter to a processing center, for completing the order,” as recited in claim 1.

These portions of Edelson only discuss data security generally. Specifically, each of the cited portions disclose the following. Col. 9, lines 23-28 discusses the use of signature recognition; col. 9, line 66 – col. 10, line 14 discusses the use of passwords and access codes; col. 15, lines 25-27 discusses viewing and print patient records only with patient approval; col. 16, lines 10-24 of Edelson discusses dynamic retrieval of electronic information in which patent data is received from multiple database and are integrated to form virtual patient record which disappears after use (see col. 15, lines 13-15 and 33-34); col. 17, lines 5-62 of Edelson discusses patient data security, including authorization techniques such as the use of photographic or fingerprint recognition to identify a system user; col. 31, lines 55-63 of Edelson discusses updating remote databases in response to authorization by a patient. Of course, fingerprint recognition and the like are vastly different than requesting patient information and (in response) sending a cover letter with identification information to the requestor (rather than verifying fingerprints, photos or whatever, all in one step).

None of the above citations remotely disclose anything about sending a cover letter or a patient authorization letter to a processing center and the context of Edelson makes doing so seem nonsensical.

In contrast to the disclosures of Eberhardt and Edelson, claim 1 recites a step of “sending, by the requestor, [a] cover letter along with a patient authorization letter to a processing center, for completing [an] order.” As discussed above, neither Eberhardt nor Edelson even disclose a cover letter. Further, Eberhardt and Edelson certainly do not disclose sending two letters, one of them a cover letter and the other a patient authorization letter.

c. The rejections should be reversed.

Neither Eberhardt nor Edelson disclose sending cover letters to requestors or returning cover letters with patient authorization letters. Since neither teaches these fundamental elements of claim 1, no combination of these two references can render the claims obvious and the rejections should be reversed.

Ordinarily, a prima facie obviousness rejection specifically identifies where each limitation is found among two or more prior art references and then identifies a specific motivation to combine the references in a way resulting in the claimed invention. Failure to do so is reversibly error. In re Dembiczak, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999) (reversing rejection because specific motivation in the prior art not identified).

Here, the rejection fails to identify with particularity two elements of the claim being rejected and even fails to identify fundamental components of the limitations, such as, who the requestor is, what is the cover letter, etc.

This deficiency also makes it impossible to address motivation to modify Eberhardt in the manner suggested in the Final Office Action because, as discussed above, the Final Office Action has failed to properly identify where two of the claim elements are to be found in Eberhardt or Edelson at all.

What is manifest, however, is that no specific motivation is cited in the Final Office Action and, as a result, the rejection cannot stand.

The Final Office Action does state that:

(B) At pages 4-5 of 23 May 2003 (sic), Applicant analyzes the applied references separately and argues each of the references individually. In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking the references individually where the rejections are based on combinations of references.... In addition, the test for obviousness is not whether the features of a second reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teaching of the references would have suggested to those of ordinary skill in the art.

This is legal error.

While one cannot show nonobviousness by “attacking” references individually, it is equally true that a rejection cannot be based only on “considering the art as a whole” in the absence of references that teach or suggest all of the claimed features and a cited specific motivation to modify the references in the manner suggested in an Office Action.

As discussed above, Eberhardt and Edelson fail to disclose or suggest one or more features of each of the Group I claims, namely “providing to the requestor a cover letter having an identifier, the identifier having order information” and “sending, by the requestor, the cover letter along with a patient authorization letter to a processing center, for completing the order.” No combination of Eberhardt and Edelson proposed in the Final Office Action can result in the claimed invention and, as the Federal Circuit and this Board have held on numerous occasions, general references to the “art as a whole” are insufficient to fill a deficiency in citing in the prior art each claim limitation and a specific motivation to combine them in the manner recited in the claim.

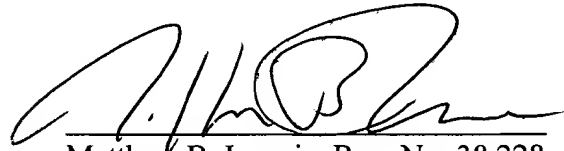
Finally, for completeness, the Applicant states that regarding claims 3 and 11, the Final Office Action applied Eberhardt and Edelsen as they were applied to claim 1. The Final Office Action merely alleges that Coli teaches a system and method wherein an online location comprises a website. The Final Office Action does not assert that Coli discloses “providing to the requestor a cover letter having an identifier, the identifier having order information” and “sending, by the requestor, the cover letter along with a patient authorization letter to a processing center, for completing the order.” Coli does not overcome the deficiencies of Eberhardt and Edelson discussed above.

The Final Office Action has failed to satisfy the elements required to establish a prima facie case of obviousness. Because failure to meet any one of these elements is sufficient to render such a rejection improper, the rejection is plainly erroneous. It is respectfully submitted that claims 1-26 are patentable over Eberhardt and Edelson and that the §103(a) rejections of these claims should be reversed.

VIII. Conclusion

For the foregoing reasons, each of the rejections of the claims was improper and should be reversed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'M. B. Lowrie', is written over a horizontal line.

Matthew B. Lowrie, Reg. No. 38,228
Jeffrey B. Powers, Reg. No. 45,021
LOWRIE, LANDO & ANASTASI, LLP
Riverfront Office Park
One Main Street
Cambridge, Massachusetts 02142
Tel. (617) 395-7000

Date: September 13, 2004
Attorney Docket No.: C1151-7000

IX. Appendix: Claims as Appealed (37 C.F.R. §41.37(c)(viii))

Claims 1-26 are pending in the application and stand rejected. The rejections of claims 1-26 are appealed.

1. A method of obtaining a patient record or document using an online location on an electronic medium, comprising:

requesting an order, by a requestor, for the patient record or document from the online location;

providing to the requestor a cover letter having an identifier, the identifier having order information;

sending, by the requestor, the cover letter along with a patient authorization letter to a processing center, for completing the order;

requesting, by the processing center, to a shipping location to ship the patient record or document to a destination location; and

obtaining, by the requestor, the patient record or document from the destination location.

2. A system for obtaining a patient record or document using an online location on an electronic medium, comprising:

means for requesting, by a requestor, an order for the patient record or document from the online location;

means for providing the requestor a cover letter having an identifier for identifying the order;

means for sending, by the requestor, the cover letter along with a patient authorization letter to a processing center;

means for requesting the patient record or document from a shipping location;

means for receiving, by a destination location, the patient record or document from the shipping location; and

means for obtaining the patient record or document from the destination location.

3. The method according to claim 1, wherein the online location comprises a web site.
4. The method according to claim 1, wherein the requestor comprises an insurance company.
5. The method according to claim 1 further comprising inputting patient information in a graphical user interface window before requesting the order.
6. The method according to claim 5, wherein the patient information includes at least one of a claim number, first name, last name, social security number, and date of birth.
7. The method according to claim 1, wherein the identifier comprises a bar code.
8. The method according to claim 1, wherein sending the cover letter comprises faxing the cover letter to the processing center.
9. The method according to claim 8 further comprising automatically reading and identifying, by the processing center, the identifier on the cover letter.
10. The system according claim 2, wherein the requestor comprises an insurance company.
11. The system according to claim 2, wherein the online location comprises a web site.
12. The system according to claim 2, wherein the means for requesting the order comprises inputting patient information in a graphical user interface window.
13. The system according to claim 2, wherein the identifier comprises a bar code.

14. The system according to claim 2, wherein sending the cover letter comprises faxing the cover letter to the processing center.

15. The system according to claim 2, wherein sending the cover letter comprises mailing the cover letter to the processing center.

16. A method of ordering, by a requestor, a patient record or document using an online location, comprising:
requesting an order for the patient record or document from the online location;
providing to the requestor a cover letter having an identifier, the identifier having order information; and
sending the cover letter along with a patient authorization letter to a processing center associated with the online location for completing the order.

17. The method according to claim 16, wherein the requestor comprises an insurance company.

18. The method according to claim 16 further comprising inputting patient information in a graphical user interface window before requesting the order.

19. The method according to claim 16, wherein the identifier comprises a bar code.

20. The method according to claim 16, wherein sending the cover letter comprises faxing the cover letter to the processing center.

21. The method of claim 1, wherein said cover letter is a paper letter.

22. The method of claim 21, wherein said patient authorization letter is a paper letter.

23. The system of claim 2, wherein said cover letter is a paper letter.
24. The system of claim 23, wherein said patient authorization letter is a paper letter.
25. The method of claim 16, wherein said cover letter is a paper letter.
26. The method of claim 25, wherein said patient authorization letter is a paper letter.